

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

Date: October 20, 2008

Applicants: Bednorz et al.

Docket: YO987-074BZ

Serial No.: 08/479,810

Group Art Unit: 1751

Filed: June 7, 1995

Examiner: M. Kopec

For: **NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH TRANSITION  
TEMPERATURE, METHODS FOR THEIR USE AND PREPARATION**

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**REPLY TO EXAMINER'S ANSWER**

**Dated 08/20/2008**

**Supplement 1**

## ARGUMENT

The Appendix to this First Supplemental Reply lists typographical errors in the Brief in addition to those listed in the Appendix of the Reply. The corrected text is listed with deletions in bold between bold double brackets, i.e, **[[text]]** , and additions in bold underlined , i.e., **text**.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

Respectfully submitted,

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**APPENDIX TO REPLY**  
**Correction to**  
**Typographical Errors in the Brief**

**In the Brief Volume 1 at page 124, lines 6 - 7,**  
**make the following change.**

**THE CAFC DECISION, ENZO BIO CHEM v. CALGENE  
SUPPORTS APPLICANTS' POSI[D]ON THAT CLAIMS ARE ENABLED**

**In the Brief Volume 1 at page 127, lines 3 -4 from the bottom,**  
**make the following change.**

There is no evidence that anything other than routine experimentation is needed to identify species within the scope of Applicants' claims as of Applicants' earlie[[r]]st filing or priority date.

**In the Brief Volume 1 at page 130, lines19-20,**  
**make the following change.**

Applicant respectfully disagrees with the Examiner. All of the claims (except 543) require  $T_c$  to be greater than or equal to 26°K. Notwithstanding, species with a  $T_c$  less than 26 K is not evidence of lack of enablement of claims directed to  $T_c$  greater than or equal to 26 K. Enablement does not require Applicant to know in advance what the  $T_c$  is, it only requires that Applicant teaches how "to make and use" the claimed invention which applicants have done and which the Examiner has not denied.

**In the Brief Volume 1 at page 134, lines 9 - 11,**

**make the following change.**

The affidavits of Shaw, Dinger, Tsuei, Mitzi and Duncombe (Brief Attachments AH, AI, AJ, AK and AL) cites numerous books and articles which provide the general teaching of ceramic science **[[at the]]** prior to Applicants' discovery.

**In the Brief Volume 1 at page 134, lines 17 - 19,**  
**make the following change.**

Mr. Duncombe's affidavit list some of the compounds prepared using the general principles of ceramic science:  $Y_1 Ba_2 Cu_3 O_x$ ;  $Y_1 Ba_2 Cu_3 O_3$ ;  $Bi_{2.15} Sr_{1.98} Ca_{1.7} Cu_2 O_{8+8}$ ;  $Ca_{(2-x)} Sr_x Cu O_x$  and  $Bi_2 Sr_2 Cu O_x$ . **Applicants note that  $Bi_{2.15} Sr_{1.98} Ca_{1.7} Cu_2 O_{8+8}$  is a BSCCO compound.**

**In the Brief Volume 1 at page 136, lines 18 - 19,**  
**make the following change.**

Examiner's conclusion "that disclosure is not fully enabling for the scope of the present claims" has not been supported.

**In the Brief Volume 1 at page 146, lines 3 - 6,**  
**make the following change.**

As stated in In re Angstadt there is no requirement for Applicants to prove that the experimentation to make compositions to practice Applicants' claimed

invention is not undue just because some experimentation is needed to select compositions that come within the scope of the Applicants claims.

**In the Brief Volume 1 at page 157, lines 3 – 6 from the bottom,  
make the following change.**

By the Examiner stating that claim 123 was allowed because it showed criticality of the formula recited, the Examiner is stating that this is a patentably distinct species, because of unexpected results, of the genius of the Ashai Shinbum Article.

**In the Brief Volume 1 at page 157, lines 3 – 8 from the bottom,  
make the following change.**

In ancestral Application Serial No. 08/303,561, filed 09/09/1994 the Office Action dated 06/25/1998 states at page 16 "Claims 24-26, 86-90 and 96-135, 137-142 are rejected under 35 USC §102(a) as being anticipated by Asahi Shinbum International Satellite Edition (London), November 11, 1986 (hereinafter, 'The Asahi Shinbum article,']" and at page 17 states "Claims 24-26, 86-90 and 96-135 and 137-142 are rejected 35 USC §103 as being unpatentable over the Asahi Shinbum article."

**In the Brief Volume 1 at page 169, lines 23 – 26,  
make the following change.**

As stated in **[[the application's]] Applicants'** prior responses, the CCPA in *In re Angstadt* has stated that if the experimentation needed to identify compositions that do not come within the scope of a claim is not "undue experimentation", then the claim is enabled.

**In the Brief Volume 1 at page 169, last line to page 170, line 4,  
make the following change.**

Guidance is needed "with respect to the direction in which the experimentation should proceed" (**Ex parte Jackson 217 USPQ 804, 807**) when more than undue experimentation is needed to make such other species. There is no evidence in the current application that anything other than **[[undue]] routine** experimentation is needed to determine species that come within the scope of Applicants' claims.

**In the Brief Volume 1 at page 173, last 2 lines,  
make the following change.**

Thus Applicants have **[[thought]] taught** "how to use" their claimed invention satisfying this requirement of 35 USC 112, first paragraph.

**In the Brief Volume 1 at page 177, lines 6-7,  
make the following change.**

For example, it can be an alkaline earth, but is not limited to an alkaline earth element.